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PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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In re Application of)

Blumer)

Serial No. 09/679,852)

Filed: October 5, 2000)

For: G PROTEIN COUPLED RECEPTORS)
FUNCTION AS OLIGOMERS)
IN VIVO)

Group Art Unit: 1647

Examiner: Bunner, B.E.

ELECTION UNDER RESTRICTION REQUIREMENT

Commissioner for Patents
Washington, D.C. 20231

NEEDLE & ROSENBERG, P.C.
Suite 1200, The Candler Building
127 Peachtree Street, N.E.
Atlanta, Georgia 30303-1811

January 18, 2002

Sir:

This is in response to the Office Action dated December 18, 2000, wherein restriction of the claims of the above-identified application is required. The Office Action requires restriction to one of the following three groups of claims:

Group I: Claims 1-5 drawn to a method of detecting oligomerization of G protein coupled receptors, classified in class 435, subclass 7.1

Group II: Claims 6-20, drawn to a method of determining whether a receptor agonist activates G protein coupled receptors and a method of screening for an

agonist/antagonist of the interaction between G protein coupled receptors,
classified in class 435, subclass 7.1.

Group III: Claims 21-26, drawn to a G protein coupled receptor fusion protein,
comprising a fluorescence donor, classified in class 530, subclass 350.

As required in response to this Action, applicants provisionally elect Group I (claims 1-5), with traverse. Applicants also request that the restriction requirement be reconsidered because the Examiner has not shown that a serious burden would be required to examine all the claims. M.P.E.P. § 803 provides:

If the search and examination of an entire application can be made without serious burden, the Examiner must examine it on the merits, even though it includes claims to distinct or independent inventions. (*Emphasis added.*)

Thus, for a restriction requirement to be proper, the Examiner must satisfy the following two criteria: (1) the existence of independent and distinct inventions (35 U.S.C. § 121); and (2) that the search and examination of the entire application cannot be made without serious burden.

Applicants respectfully assert that the Examiner has not shown that the second requirement has been met, on the basis that the Examiner has not shown that it would be serious burden to search and examine all of the claims together.

For example, Groups I and II are both classified in class 435, subclass 7.1. Since both groups are classified in the same class and subclass, it is unclear as to why these two groups would not be examined together since the search should be coextensive. Thus, Applicants believe that it would not be a serious burden on the Examiner to search and examine the claims of Groups I and II together.

Examining the claims together would eliminate the necessity of prosecuting multiple, separate, yet intimately related, applications. Thus, this criterion of M.P.E.P. § 803 as set forth above has not been satisfied, because the Examiner has not shown that it would be a serious burden to search and examine all of the claims of this invention together.

The Office Action also states that Applicants are required under 35 U.S.C. § 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable.

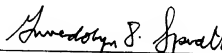
Thus, with regard to the types of G protein coupled receptors in the methods of Group I, applicants provisionally elect the species wherein the first and second G protein coupled receptor regions of the fusion protein are the same. Claims 1, 2, 4 and 5 are readable on the elected species. Applicants acknowledge that, upon allowance of a generic claim, applicants will be entitled to consideration of claims to additional species.

For the reasons stated above, applicants respectfully assert that restriction of the claims as set forth by the Examiner would be contrary to promoting efficiency, economy and expediency in the Patent Office and further point out that restriction by the Examiner is discretionary (M.P.E.P. § 803.01). Thus, applicants respectfully request that all of the claims of this application be examined together. Consequently, reconsideration and modification or withdrawal of the restriction requirement is requested.

Applicants also wish to remind the Examiner of the guidelines for rejoinder of claims as set forth in M.P.E.P. § 821.04, as they apply to the pending claims of the instant application.

No fees are believed due. However, the Commissioner is hereby authorized to charge any additional fees which may be required, or credit any overpayment to Deposit Account No. 14-0629.

Respectfully submitted,



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I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner for Patents, Washington, D.C. 20231, on the date shown below.


Gwendolyn D. Spratt

1-18-02
Date